

Docket 91255JLT  
Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Murray Figov

OFFSET PRINTING BLANK AND  
METHOD OF IMAGING BY INK  
JET

Serial No. 10/538,489

Filed 08 December 2003

Mail Stop APPEAL BRIEF-PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Group Art Unit: 2854

Examiner: Zimmerman, Joshua D.

Sir:

**APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134**

## **Table Of Contents**

<u>Table Of Contents</u> .....	i
<u>Real Party In Interest</u> .....	1
<u>Related Appeals And Interferences</u> .....	1
<u>Status Of Claims</u> .....	1
<u>Status Of Amendments</u> .....	1
<u>Summary of Claimed Subject Matter</u> .....	2
<u>Grounds of Rejection to be Reviewed on Appeal</u> .....	3
<u>Arguments</u> .....	4
<u>Ground B (Patentability):</u> .....	8
<u>Conclusion</u> .....	10
<u>Appendix I - Claims on Appeal</u> .....	12
<u>Appendix II - Evidence</u> .....	14
<u>Appendix III – Related Proceedings</u> .....	15
<u>Appendix IV – Prosecution Documents</u> .....	16

## **APPELLANT'S BRIEF ON APPEAL**

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's Final Rejections of claims 40-59, 61, and 69-71 that are contained in the Office Action mailed March 22, 2007.

A timely Notice of Appeal was filed September 24, 2007.

### **Real Party In Interest**

Eastman Kodak Company is the real party in interest.

### **Related Appeals And Interferences**

No appeals or interferences are known that will directly affect or be directly affected by or have bearing on the Board's decision in the present appeal.

### **Status Of Claims**

Claims 40-45, 49, 50, 53, and 71 stand finally rejected on several prior art grounds and are the subject matter of this appeal.

Claims 1-39, 46-48, 51, 52, and 54-70 have been cancelled.

Appendix I contains a clean, double-spaced copy of the claims on appeal.

### **Status Of Amendments**

No amendments have been filed subsequent to filing the appeal.

However, Appellant submitted a Second Amendment and Request for Reconsideration under Rule 116 on June 12, 2007 in which a number of claims were amended with subject matter from cancelled dependent claims in order to expedite prosecution.

An Examiner's Advisory Action was mailed July 10, 2007 refusing entry of Appellant's amendments.

Appellant submitted a Petition under Rule 181 in a timely fashion on July 20, 2007 asking for entry of the previously submitted claim amendments.

Appellant has not received a Decision on that Petition, and in order to avoid unnecessary fees for Extension of Time, this Appeal Brief is being submitted with the expectation that his Petition will be granted.

A copy of each of these three papers is provided with this Brief in Appendix IV.

Because a number of claims were cancelled with the Rule 116 amendment, several of the rejections made in the Final Rejection are moot, as noted below.

### **Summary of Claimed Subject Matter**

Appellant has found a way to provide lithographic printing blanks or precursors using a specific coating composition that can be changed from hydrophilic to oleophilic, or from oleophilic to hydrophilic, by ink jet application of an ink onto the coating. The ink includes specific components, depending upon the character of the coating composition, to give imaged areas that have either hydrophilic or oleophilic properties that are opposite the properties of the non-imaged areas.

Specifically, as called for in Appellant's Claim 40, the coating composition that can be changed with the ink includes 1 to 15 wt.% polyvinyl alcohol, 20-60 wt.% of polyacrylic acid, 25-55 wt.% of a hydrophobic water-based emulsion having a pH of 7 or below, an aminoplast in an amount depending upon the property of the coating (not more than 10% dry weight when the coating is hydrophilic and between 10% and 20% dry weight when the coating is oleophilic), and a wetting agent. As pointed out in Appellant's application (pages 11, lines 7-22 and 12, lines 6-10), use of the claimed element coating and an appropriate ink jet ink provides an imaged element that requires no post-imaging processing other than an optional heating step. Thus, processing of imaged elements with alkaline developers that are common in the lithographic printing industry is avoided (page 8, lines 13-22). Moreover, with some modest design effort, the coating composition can be used to provide either positive or negative images. This flexibility is not common in known lithographic printing elements because each type of element must be specifically designed and processed after imaging appropriate to whether they are positive-working or negative-working. The specific coating compositions used in the practice of Appellant's invention are also environmentally-friendly, which is an increasingly important consideration in today's market.

Appellant's single independent claim is now briefly described with an indication of specific support in the original disclosure:

**Claim 40:**

Appellant's Claim 40 is directed to a lithographic printing blank comprising a coating deposited from aqueous fluid onto a substrate, the coating comprising:

polyvinyl alcohol that is present at between 1% and 15% of the dry coating weight;

polyacrylic acid that is present at between 20% and 60% of the dry coating weight;

hydrophobic water-based emulsion with pH of 7 or below that is present at between 25% and 55% of the dry coating weight;

aminoplast that is present at not more than 10% of the dry coating weight when the coating is hydrophilic, and between 10% and 20% of the dry coating weight when the coating is oleophilic; and

at least one wetting agent.

Claim 40 is described on pages 11 (lines 2-3), 12 (lines 17-18 and 21-23), 13 (lines 4-5, 9, and 16-17), 14 (lines 3, and 11-22), and 19 (lines 10-16) of the original disclosure.

**Grounds of Rejection to be Reviewed on Appeal**

The two following grounds of rejection are presented for review by the Board of Patent Appeals and Interferences:

Ground A (Rejection I): Whether Appellant's claimed invention is novel over EP 1,057,622A2 (Fukino et al).

Ground B (Rejections II-VII): Whether Appellant's claimed invention is patentable over various combinations of cited art:

II. Claims 48 and 71 have been rejected as unpatentable over Fukino et al. Claim 48 has been cancelled so only Claim 71 is rejected.

III. Claim 42 has been rejected as unpatentable over Fukino et al. with US 5,820,932 (Hallman et al.).

IV. Claims 54-56, 59, and 61 have been rejected as unpatentable over Fukino et al. with US 2001/0019760 (Kawamura) and US 6,444,750 (Touhsaent). All of these claims have been cancelled so this rejection is moot.

V. Claims 57-58 have been rejected as unpatentable over Fukino et al. with Kawamura, Touhsaent, US 2002/0054981 (Deutsch et al.), and US 5,556,583 (Tashiro et al.). Claims 57-58 have been cancelled so this rejection is moot.

VI. Claim 69 has been rejected as unpatentable over Fukino et al. in view of Karamura and Touhsaent. Claim 69 has been cancelled so this rejection is moot.

VII. Claim 70 has been rejected as unpatentable over Fukino et al. with Kawamura, Touhsaent and “applicant’s admitted prior art”. Claim 70 has been cancelled so this rejection is moot.

Only Rejections I, II, and III are argued below.

## **Arguments**

Before the Board considers the following arguments, Appellant would respectfully ask that the members again review the discussion above in the “Summary” relating to a discussion of his claimed invention.

### **Ground A (Novelty):**

It is believed that the presently claimed invention in Claim 40 is novel over Fukino et al., and that all claims dependent thereon (41-45, 49, 50, 53, and 71) are also novel, at least by virtue of their dependency.

Fukino et al. describes a lithographic printing plate precursor that has an imaging composition that is sensitive to, and therefore imaged by, imaging radiation (e.g. from a laser beam) to prepare a printing plate without the use of conventional developing steps [0027]. To have required sensitivity to imaging radiation, the imageable layer must include a “light/heat converting agent” [0034].

The imaging composition includes an irradiation “oxidizable compound” in an amount of 0.1-50 wt.% [0165]. This compound is present to accelerate the precipitation of a metallic fine piece that is used to provide an oleophilic surface [0136] from the action of thermal imaging. Polyvinyl alcohol (PVA) and polyacrylic acid are listed as possible oxidizable compounds among dozens of possible compounds. However, there is no explicit teaching that combinations or mixtures of these polymers should be used. A variety of other compounds are taught in combinations [0216] and [0221] but not the polyvinyl alcohol and polyacrylic acid. Moreover, there is no teaching in [0165] of preferences, but it would appear from at least [0181] that saccharides and carbohydrates may be preferred, not PVA or polyacrylic acid. Considering the lengthy list in [0165], no combinations are mentioned or hinted at. Glucose is used as an oxidizable compound in Example II-10. If some of the compound listed in Fukino et al. are combined, such as sorbitol and formaldehyde, the sorbitol would digest the formaldehyde and the combination would have no positive effect. In addition, [0165] lists formaldehyde and phenols. If these two are combined, they would form a phenol-formaldehyde resin, reducing the desired effect of the compounds, which is completely contrary to the purpose of the material in Fukino et al. Thus, it does not make sense to combine the compounds listed by Fukino et al. and to do so as the Final Rejection has done is contrary to scientific understanding.

A variety of other components are taught in Fukino et al. because of its unique imaging composition and method (i.e. irradiation and use of metal formation). For example, what is known as an “organic high molecular weight compound having an hydroxyl group” [0246] is also said to be present in the image-recording layer. A large variety of hydroxy-containing organic high molecular weight compounds are described including PVA and polyacrylic acid. However, contrary to the arguments from the Office throughout this prosecution, there is no explicit teaching that PVA and polyacrylic acid should be used together for this component either. The Examples of Fukino et al. show the use of PVA or polyacrylic acid alone (Examples II-6 and II-11), not in combination. It is

also apparent that there is no explicit teaching of the amount of either the PVA or polyacrylic acid, when each is used individually in the image-recording layer.

Moreover, gelatin is the preferred organic high molecular weight compound having a hydroxyl group [0249] and this material can be hardened using conventional gelatin hardeners [0252].

In [0247]-[0248], Fukino et al. further teaches the presence of a “waterproofing agent” for crosslinking and curing the “organic high molecular weight compound having a hydroxyl group” described in [0246]. It is clear from the context that this catalyst is not for reaction with the “oxidizable compound” of [0165] or the “organic high molecular compound” (see below). The useful amounts of the “waterproofing” agent are not described except for the gelatin-hardening compound [0254].

The image-recording layer can also include an “organic high molecular compound” [0266]-[0268]. This component is to be distinguished from the “organic high molecular weight compound having an hydroxyl group” described above. Such organic high molecular compounds can include various polymers and water emulsions, including emulsions of polyurethane resins. Such components are present in an amount of 1 to 20 wt.%, preferably 2-10 wt.% of the solids content of the image-recording layer [0269].

It should also be noted that Fukino et al. [0012] teaches away from use of the compositions used for ink jet plate making such as those of the presently claimed invention. Fukino et al. seems to be teaching that it is simpler to image after printing not during the ink jet process.

With this teaching of Fukino et al. in mind, Appellant’s claimed invention is novel for several reasons.

Reason 1: Appellant’s coating comprises both polyvinyl alcohol (at 1-15 wt.%) and polyacrylic acid (at 20-60 wt.%). The Final Rejection points to [0165] and [0246] for a teaching of PVA or polyacrylic acid, which apparently can be present to serve either of two purposes. The Final Rejection then points to [0246] for a teaching of polyacrylic acid. In neither place does Fukino et al. describe or suggest that both PVA and polyacrylic acid should be used in the same recording layer. The Final Rejection seems to speculate that



such teaching suggests a combination but Appellant argues that it doesn't put his specific combination "in the public domain" as required by Section 102, *In re LeGrice* 133 USPQ 365, at 369 (CCPA, 1962) and *In re Wilder* 166 USPQ 545 (CCPA, 1970). There are hundreds of possible combinations of the materials in [0165] with the materials in [0246] but nothing points to combining PVA with polyacrylic acid among those hundreds of possible combinations. In fact, the most reasonable combination suggested by these paragraphs would be glucose (or another saccharide) with gelatin—those are the preferences described in Fukino et al.

From the teaching in [0165] and [0246], there is no clear description of Appellant's amounts of PVA and polyacrylic acid. If [0165] is used to describe PVA and [0246] is used to describe polyacrylic acid, there is no description of 20-60 wt.% for polyacrylic acid in [0246]. If [0165] is used to describe polyacrylic acid and [0246] is used to describe PVA, there is no teaching of 1-15 wt.% for PVA in [0246]. The Office cannot have it both ways—citing a combination of two different polymers from two different paragraphs but using only one paragraph for the amounts of both polymers. That is clearly not the intent of Fukino et al., and Appellant's claimed combination is not described when the teaching of Fukino et al. is properly interpreted.

Reason 2: Appellant's claimed invention also includes 25-55 wt.% of a hydrophobic water-based emulsion. The Final Rejection further alleges that Fukino et al. describes the hydrophobic water-based emulsion in [0267]. However, the amount of this component described in Fukino et al. [0269] is only 1-20 wt.%, which is very different from that required in Claim 40.

Reason 3: Appellant's claimed invention further includes an aminoplast in an amount of not more than 10 wt.% if the coating is hydrophilic and 10-20 wt.% if the coating is oleophilic. The Final Rejection argues that aminoplasts are taught in [247], which compounds are apparently used to crosslink or cure the "high molecular compounds" of [0246]. No amounts of such components are described in Fukino et al. Only the preferred hardeners for the preferred gelatin are quantified [0254] but this also is suspect because the amount

of gelatin is not described. Thus, Fukino et al. does not describe Appellant's amount of aminoplast.

In arguing about individual claims, the Final Rejection argues that Appellant's Claims 46 and 47 (amounts of PVA and polyacrylic acid now part of Claim 40) are described in [0165]. As pointed out above, there is no combination of polymers described in [0165] or [0246]. Amounts are taught only in [0165], and those amounts do not describe Appellant's different amounts for different polymers. Thus, Fukino et al. fails to describe the very different amounts of both polymers when used in combination.

The Final Rejection also argues that Fukino et al. describes the amount of aminoplasts of Claims 51 and 52 (now part of Claim 40). This is incorrect since while the Final Rejection points to [0247] as describing the aminoplasts but there are no amounts described therein.

The remaining dependent Claims 41, 43, 44, 45, 49, 50, and 53 are novel based on their dependence upon novel Claim 40.

For the reasons presented above, the Section 102(b) final rejection of Claims 40, 41, 43-47, and 49-53 should be reversed.

Ground B (Patentability):

While Claim 48 has been cancelled and its subject matter has been incorporated into Claim 40, Appellant would respond to specific comments in the Final Rejection relating to Claim 48. The Final Rejection argues that the subject matter of former Claim 48 is obvious in view of the "range of concentrations in paragraph 269". Because Fukino et al. teaches a range of concentrations for various components, the Final Rejection speculates that it would be obvious to one of ordinary skill in the art to use 25-55 wt.%, even though Fukino et al. discloses only 1-20 wt.%, in order to optimize hydrophilicity.

The subject matter of former Claim 48 does not stand alone, and the combination of components and their amounts in amended Claim 40 is certainly not obvious from any teaching in Fukino et al. or from speculation as to what one skilled in the art might choose. Secondly, it is submitted that nothing in

all of the ranges of components in Fukino et al. would suggest that the “organic high molecular compound” of [0266] would be used at any level other than the explicit amounts taught in [0269]. The amounts of all components must be taken at face value as directed to those components only, not extended to any other component in the composition described by Fukino et al., and not particularly to components that already have an explicit teaching as to the amount. Basically, the Final Rejection is saying that one skilled in the art would ignore the teaching in [0269] or extend it to optimize hydrophilicity but fails to say why a skilled worker would extend it. Appellant does not believe that Section 103 allows the USPTO to ignore explicit teaching in the art in order to get a different result, or to extend the explicit teaching to Applicant’s different and broader range. Such speculation is not based on either the prior art teaching or common sense, but can be derived only with the “roadmap” provided by Appellant’s own teaching. The Final Rejection is correct that it is “one having ordinary skill in the art” that would interpret the art teaching, but that person would not have the benefit of Appellant’s disclosure that teaches the specific combination of PVA and polyacrylic acid.

With respect to Claim 71, the Final Rejection argues that the catalysts described in Fukino et al. [0248] are not necessary. Appellant would point out that the “organic high molecular compounds” of [0246] require some type of crosslinking or hardening and when gelatin is used as such compound, a gelatin hardener is used [0251]. It would be intuitive (common sense) to a person of ordinary skill in the art that crosslinking catalysts or hardeners would be preferential to leaving them out. Appellant’s Claim 71 clearly omits such catalysts, contrary to the suggestions in Fukino et al. Appellant’s specification (page 15, lines 20-23) explicitly teaches that such catalysts are unsuitable for use with the aminoplasts. They are not merely “optional”. They must be excluded in Appellant’s claimed invention, but in Fukino et al., they may be used.

In addition, the subject matter of Claim 71 does not stand alone but is combined with amended Claim 40, and the combination of subject matter from both claims is not obvious from Fukino et al. since the reference fails to teach or

suggest the combination of components, their amounts, and the omission of a crosslinking catalyst.

For these reasons, the unpatentability rejection of Claim 71 should be reversed.

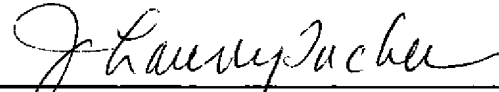
Claim 42 has also been rejected as unpatentable over the combined teaching in Fukino et al. and US 5,820,932 (Hallman et al.). Claim 42 calls for the coating on the substrate to be oleophilic. Even if the Final Rejection arguments about Fukino et al. and Hallmann et al. are accepted for argument's sake in relation to Claim 42, the combination of subject matter in Claims 40 and 42 is not taught or suggested in Fukino et al. with Hallman et al. As pointed out above, Fukino et al. fails to describe the use combination of components and their amounts as called for in Claim 40. Nothing in Hallman et al. would overcome this deficiency. Moreover, nothing in Hallman et al. would overcome the difference between Fukino et al. and the presently claimed invention in relation to the different types of imaging compositions. Hallman et al. teaches the use of hydrophobic material that is washed away in non-imaged areas. So, even if Hallman et al. provides a suggestion of an oleophilic coating, which Appellant is not admitting, the combined teaching still fails to suggest the presently claimed invention having a permanent layer comprised of specific amounts of specific components that is not washed away. Thus, the unpatentability rejection of Claim 42 is improper and should be reversed.

### **Conclusion**

For the above reasons, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Section 102(b) and 103(a) rejections

of the Final Rejection and mandate the allowance of all remaining Claims 40-45, 49, 50, 53, and 71.

Respectfully submitted,

A handwritten signature in cursive script, reading "J. Lanny Tucker", written in dark ink.

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Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

### **Appendix I - Claims on Appeal**

40. A lithographic printing blank comprising a coating deposited from aqueous fluid onto a substrate, the coating comprising:
- polyvinyl alcohol that is present at between 1% and 15% of the dry coating weight;
  - polyacrylic acid that is present at between 20% and 60% of the dry coating weight;
  - hydrophobic water-based emulsion with pH of 7 or below that is present at between 25% and 55% of the dry coating weight;
  - aminoplast that is present at not more than 10% of the dry coating weight when the coating is hydrophilic, and between 10% and 20% of the dry coating weight when the coating is oleophilic; and
  - at least one wetting agent.
41. The lithographic printing blank of claim 40, wherein the coating is hydrophilic.
42. The lithographic printing blank of claim 40, wherein the coating is oleophilic.
43. The lithographic printing blank of claim 40, wherein the aminoplast is a urea-formaldehyde resin.
44. The lithographic printing blank of claim 40, wherein the hydrophobic water-based emulsion has one of a phenol formaldehyde and an acrylic polymer or copolymer as its internal phase.
45. The lithographic printing blank of claim 40, wherein the coating has a dry coating weight between 1 gram per square meter and 4 grams per square meter.

- 49. The lithographic printing blank of claim 40, wherein the wetting agent comprises silicone surfactant.
- 50. The lithographic printing blank of claim 40, wherein the at least one wetting agent is present at between 0.5% and 7% of the dry coating weight.
- 53. The lithographic printing blank of claim 40, wherein the substrate comprises one of untreated aluminum, aluminum treated with phosphoric acid and anodized aluminum.
- 71. The lithographic printing blank of claim 40 wherein a crosslinking catalyst for the aminoplast is absent from said deposited coating.

## **Appendix II - Evidence**

None



### **Appendix III – Related Proceedings**

None

#### **Appendix IV – Prosecution Documents**

- A. A copy of Appellant's Second Amendment and Request for Reconsideration submitted June 12, 2007 under Rule 116.
- B. A copy of the Examiner's Advisory Action mailed July 10, 2007.
- C. A copy of Appellant's Petition under Rule 181 submitted July 20, 2007.

**Response under 37 C.F.R. 1.116  
- Expedited Examining Procedure -  
Examining Group 2854**

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**Customer No. 01333**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Murray Figov

OFFSET PRINTING BLANK AND  
METHOD OF IMAGING BY INK JET

Serial No. 10/538,489

Filed 08 December 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Sir:

Group Art Unit: 2854

Examiner: Zimmerman, Joshua D.

*submitted 6/12/07*

**SECOND AMENDMENT AND REQUEST FOR RECONSIDERATION  
UNDER 37 C.F.R. 1.116**

In response to the FINAL Office Action mailed March 22, 2007  
and the Advisory Action mailed May 25, 2007, please amend the above-identified  
application, without prejudice or disclaimer, as follows:

**Amendments to the Claims** are reflected in the listing of claims that begins on  
page 2 of this paper.

**Remarks/Arguments** begin on page 4 of this paper.

**Listing of Claims:**

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. –39. (cancelled)

40. (currently amended) A lithographic printing blank comprising a coating deposited from aqueous fluid onto a substrate, the coating comprising:  
polyvinyl alcohol that is present at between 1% and 15% of the dry coating weight;  
polyacrylic acid that is present at between 20% and 60% of the dry coating weight;  
hydrophobic water-based emulsion with pH of 7 or below that is present at between 25% and 55% of the dry coating weight;  
aminoplast that is present at not more than 10% of the dry coating weight when the coating is hydrophilic, and between 10% and 20% of the dry coating weight when the coating is oleophilic; and  
at least one wetting agent.

41. (previously presented) The lithographic printing blank of claim 40, wherein the coating is hydrophilic.
42. (previously presented) The lithographic printing blank of claim 40, wherein the coating is oleophilic.
43. (previously presented) The lithographic printing blank of claim 40, wherein the aminoplast is a urea-formaldehyde resin.
44. (previously presented) The lithographic printing blank of claim 40, wherein the hydrophobic water-based emulsion has one of a phenol formaldehyde and an acrylic polymer or copolymer as its internal phase.

45. (previously presented) The lithographic printing blank of claim 40, wherein the coating has a dry coating weight between 1 gram per square meter and 4 grams per square meter.
- 46.-48. (cancelled)
49. (previously presented) The lithographic printing blank of claim 40, wherein the wetting agent comprises silicone surfactant.
50. (previously presented) The lithographic printing blank of claim 40, wherein the at least one wetting agent is present at between 0.5% and 7% of the dry coating weight.
- 51.-52. (cancelled)
53. (previously presented) The lithographic printing blank of claim 40, wherein the substrate comprises one of untreated aluminum, aluminum treated with phosphoric acid and anodized aluminum.
- 54.-70. (cancelled)
71. (previously presented) The lithographic printing blank of claim 40 wherein a crosslinking catalyst for the aminoplast is absent from said deposited coating.

### **REMARKS/ARGUMENTS**

The present application has been “finally” rejected and several amendments to the claims are presented in a good faith attempt to overcome all rejections, to expedite allowance, and to avoid an appeal. In particular, Claim 40 has been amended to include the subject matter of cancelled Claims 46-48, 51, and 52. Thus, the subject matter added to the independent claim has been previously searched and considered. These amendments should not raise a new issue and in fact should reduce issues so that it is easier for the Examiner to agree with Applicant’s arguments for both novelty and non-obviousness.

Claims 54-70 have been cancelled in order to expedite allowance of this application, but Applicant reserves the right to submit the same or similar subject matter in future continuing or divisional applications.

Therefore, Applicant respectfully requests entry, consideration of these amendments, and allowance of this application for the reasons presented below.

#### **Applicant’s Claimed Invention:**

Applicant has found a way to provide lithographic printing blanks or precursors using a specific coating composition that can be changed from hydrophilic or oleophilic, or from oleophilic to hydrophilic, by ink jet application of an ink onto the coating. The ink includes specific components, depending upon the character of the coating composition, to give imaged areas either hydrophilic or oleophilic properties that are opposite those of the non-imaged areas.

Specifically, as called for in amended Claim 40, the coating composition includes 1% to 15% polyvinyl alcohol, 20%-60% of polyacrylic acid, 25%-55% of a hydrophobic water-based emulsion having a pH of 7 or below, an aminoplast in an amount depending upon the hydrophilicity or oleophilicity of the coating, and a wetting agent. As pointed out in Applicant’s application this combination of components in the coating and the use of an appropriate ink jet ink, provides an imaged element that requires no post-imaging processing other than an optional heating step. Thus, processing of imaged elements with alkaline developers that are common in the lithographic printing industry is avoided.

Moreover, with some modest design effort, the coating composition can be used to provide either positive or negative images. This flexibility is not common in conventional lithographic printing elements because each type of element must be specifically designed and processed after imaging appropriate to whether they are positive-working or negative-working. The specific coating compositions used in the practice of this invention are also environmentally-friendly, which is an increasingly important consideration in today's market.

#### **Rejection Under 35 U.S.C. §102(b)**

Claims 40, 41, 43-47, and 49-53 have been rejected as being anticipated by EP 1,057,622 (Fukino et al.). This rejection is respectfully traversed.

Applicant will provide a detailed discussion of Fukino et al. at this point, not just for this rejection but also for all of the Section 103 rejections discussed below, since Fukino et al. is cited as the basic teaching for all rejections.

It is believed that the presently claimed invention in Claim 40 is novel over Fukino et al., and that all claims dependent there on are also novel, at least by virtue of their dependency.

Fukino et al. describes a lithographic printing plate precursor that has an imaging composition that is sensitive to, and therefore imaged by, imaging radiation (e.g. from a laser beam) to prepare a printing plate without the use of conventional developing steps [0027]. To have required sensitivity to imaging radiation, the imageable layer must include a "light/heat converting agent" [0034].

The imaging composition includes an irradiation "oxidizable compound" in an amount of 0.1-50 wt% [0165]. This compound is present to accelerate the precipitation of a metallic fine piece that is used to provide an oleophilic surface [0136] from the action of thermal imaging. Polyvinyl alcohol (PVA) and polyacrylic acid are listed as possible oxidizable compounds among dozens of possible compounds. However, there is no explicit teaching that combinations or mixtures of these compounds should be used. Moreover, there is no teaching in [0165] of preferences, but it would appear from at least [0181] that saccharides and carbohydrates are preferred, not PVA or polyacrylic acid. Glucose is used as an oxidizable compound in Example II-10.

A variety of other components are taught in Fukino et al. because of its unique imaging composition and method (i.e. irradiation and use of metal formation). For example, what is known as a “organic high molecular weight compound having an hydroxyl group” [0246] is also said to be present in the image-recording layer. A large variety of hydroxy-containing organic high molecular weight compounds are described including PVA and polyacrylic acid. However, contrary to the arguments from the Office throughout this prosecution, there is no explicit teaching that PVA and polyacrylic acid should be used together for this component either. The Examples of Fukino et al. show the use of PVA or polyacrylic acid alone (Examples II-6 and II-11), not in combination. It is also apparent that there is no explicit teaching of the amount of either the PVA or polyacrylic acid, when each is used individually in the image-recording layer.

Moreover, gelatin is the preferred organic high molecular weight compound having a hydroxyl group [0249] and this material can be hardened using conventional gelatin hardeners [0252].

In [0247]-[0248], Fukino et al. further teaches the presence of a “waterproofing agent” for crosslinking and curing the “organic high molecular weight compound having a hydroxyl group” described in [0246]. It is clear from the context that this catalyst is not for reaction with the “oxidizable compound” of [0165] or the “organic high molecular compound” (see below). The useful amounts of the “waterproofing” agent are not described except for the gelatin-hardening compound [0254].

The image-recording layer can also include an “organic high molecular compound” [0266]-[0268]. This component is to be distinguished from the “organic high molecular weight compound having an hydroxyl group” described above. Such organic high molecular compounds can include various polymers and water emulsions, including emulsions of polyurethane resins. Such components are present in an amount of 1 to 20 wt%, preferably 2-10 wt% of the solids content of the image-recording layer [0269].

With this teaching of Fukino et al. in mind, Applicant would like to explain how his claimed invention is novel.

A) Applicant’s coating comprises both polyvinyl alcohol (at 1-15%) and polyacrylic acid (at 20-60%). The Office Action points to [0165] and [0246] for a teaching of PVA or polyacrylic acid, which apparently can be present



to serve either of two purposes. The Office Action then points to [0246] for a teaching of polyacrylic acid. In neither place does Fukino et al. describe or suggest that both PVA and polyacrylic acid should be used in the same recording layer. The Office Action might speculate that such teaching suggests a combination but it doesn't put Applicant's specific combination "in the public domain" as required by Section 102, *In re LeGrice* 133 USPQ 365, at 369 (CCPA, 1962) and *In re Wilder* 166 USPQ 545 (CCPA, 1970). There are hundreds of possible combinations of the materials in [0165] with the materials in [0246] but nothing points to combining PVA with polyacrylic acid among those hundreds of possible combinations. In fact, the most reasonable combination suggested by these paragraphs would be glucose (or another saccharide) with gelatin—those are the preferences described in Fukino et al.

From the teaching in [0165] and [0246], there is no clear description of Applicant's amounts of PVA and polyacrylic acid. If [0165] is used to describe PVA and [0246] is used to describe polyacrylic acid, there is no description of 20-60 wt% for polyacrylic acid in [0246]. If [0165] is used to describe polyacrylic acid and [0246] is used to describe PVA, there is no teaching of 1-15 wt% for PVA in [0246]. The Office cannot have it both ways—citing a combination of two different polymers from two different paragraphs but using only one paragraph for the amounts of both polymers. That is clearly not the intent of Fukino et al., and Applicant's claimed combination is not described when the teaching of Fukino et al. is properly interpreted.

B) Applicant's claimed invention also includes 25-55 wt% of a hydrophobic water-based emulsion. The Office Action further alleges that Fukino et al. describes the hydrophobic water-based emulsion in [0267]. However, the amount of this component described in Fukino et al. [0269] is only 1-20 wt%, which is very different from that required in Claim 40.

C) Applicant's claimed invention further includes an aminoplast in an amount of not more than 10% if the coating is hydrophilic and 10-20% if the coating is oleophilic. The Office Action argues that aminoplasts are taught in [247], which compounds are apparently used to crosslink or cure the "high molecular compounds" of [0246]. No amounts of such components are described in Fukino et al. Only the preferred hardeners for the preferred gelatin are quantified [0254] but this also is suspect because the amount of gelatin is not

described. Thus, Fukino et al. does not described Applicant's amount of aminoplast.

In arguing about individual claims, the Office Action argues that Applicant's Claims 46 and 47 (amounts of PVA and polyacrylic acid now part of Claim 40) are described in [0165]. As pointed out above, there is no combination of polymers described in [0165] or [0246]. Amounts are taught only in [0165], and those amounts do not describe Applicant's different amounts for different polymers. Thus, Fukino et al. fails to describe the very different amounts of both polymers when used in combination.

The Office Action also argues that Fukino et al. describes the amount of aminoplasts of Claims 51 and 52 (now part of Claim 40). This is incorrect since the Office Action points to [0247] as describing the aminoplasts but there are no amounts described therein.

The remaining dependent Claims 41, 43, 44, 45, 49, 50, and 53 are novel based on their dependence upon novel Claim 40.

For the reasons presented above, the Section 102(b) rejection of Claims 40, 41, 43-47, and 49-53 should be withdrawn.

#### **Rejections Under 35 U.S.C. §103(a)**

I. Claims 48 and 71 have been rejected as unpatentable over Fukino et al.

II. Claim 42 has been rejected as unpatentable over Fukino et al. with US 5,820,932 (Hallman et al.).

III. Claims 54-56, 59, and 61 have been rejected as unpatentable over Fukino et al. with US 2001/0019760 (Kawamura) and US 6,444,750 (Touhsaent).

IV. Claims 57 and 58 have been rejected as unpatentable over Fukino et al. with Kawamura, Touhsaent, US 2002/0054981 (Deutsch et al.), and US 5,556,583 (Tashiro et al.).

V. Claim 69 has been rejected as unpatentable over Fukino et al. in view of Karamura and Touhsaent.

VI. Claim 70 has been rejected as unpatentable over Fukino et al. with Kawamura, Touhsaent and "applicant's admitted prior art".

All of these rejections are traversed and addressed in turn below.

### Rejection I:

The Office Action argues that the subject matter of Claim 48 (now part of amended Claim 40) is obvious in view of the “range of concentrations in paragraph 269”. Because Fukino et al. teaches a range of concentrations for various components, the Office Action speculates that it would be obvious to one of ordinary skill in the art to use 25-55 wt%, even though Fukino et al. discloses only 1-20 wt%, in order to optimize hydrophilicity.

First of all, the subject matter of former Claim 48 does not stand alone, and the combination of components and their amounts in amended Claim 40 is certainly not obvious from any teaching in Fukino et al. or from speculation as to what one skilled in the art might choose. Secondly, it is certainly apparent that nothing in all of the ranges of components in Fukino et al. would suggest that the “organic high molecular compound” of [0266] would be used at any level other than the explicit amounts taught in [0269]. The amounts of all components must be taken at face value as directed to those components only, not extended to any other component in the composition described by Fukino et al., and not particularly to components that already have an explicit teaching as to the amount. Basically, the Office Action is saying that one skilled in the art would ignore the teaching in [0269] or extend it to optimize hydrophilicity but fails to say why a skilled worker would extend it. Applicant does not believe that Section 103 allows the USPTO to ignore explicit teaching in the art in order to get a different result, or to extend the explicit teaching to Applicant’s different and broader range. Such speculation is not based on the prior art teaching, but the “roadmap” provided by Applicant’s own teaching. The Office Action is correct that it is “one having ordinary skill in the art” that would interpret the art teaching, but that person would not have the benefit of Applicant’s disclosure that teaches the specific combination of PVA and polyacrylic acid.

With respect to Claim 71, the Office Action alleges that the catalysts described in Fukino et al. [0248] are not necessary. Applicant would agree that the catalysts in that paragraph are optional, but the “organic high molecular compounds” of [0246] require some type of crosslinking or hardener and when gelatin is used as such compound, a gelatin hardener is used [0251]. It would be intuitive to a person of ordinary skill in the art that crosslinking catalysts

or hardeners would be preferential to leaving them out. Applicant's Claim 71 clearly omits such catalysts, contrary to the suggestions in Fukino et al.

In addition, the subject matter of Claim 71 does not stand alone but is combined with amended Claim 40, and the combination of subject matter from both claims is not obvious from Fukino et al. since the reference fails to teach or suggest the combination of components, their amounts, and the omission of a crosslinking catalyst.

For these reasons, the rejection of Claims 48 and 71 should be withdrawn.

#### Rejection II:

Claim 42 has also been rejected as unpatentable over the combined teaching in Fukino et al. and US 5,820,932 (Hallman et al.). Claim 42 calls for the coating on the substrate to be oleophilic. Even if the Office Action arguments about Fukino et al. and Hallmann et al. are accepted for argument sake in relation to Claim 42, the combination of subject matter in amended Claim 40 and Claim 42 is not taught or suggested in Fukino et al. with Hallman et al. As pointed out above, Fukino et al. fails to describe the use combination of components and their amounts as called for in Claim 40. Nothing in Hallman et al. would overcome this deficiency. Moreover, nothing in Hallman et al. would overcome the difference between Fukino et al. and the presently claimed invention in relation to the different types of imaging compositions. Hallman et al. teaches the use of hydrophobic material that is washed away in non-imaged areas. So, even if Hallman et al. provides a suggestion of an oleophilic coating, which Applicant is not admitting, the combined teaching still fails to suggest the presently claimed invention having a permanent layer comprised of specific amounts of specific components, that is not washed away. Thus, the rejection of Claim 42 is improper and should be withdrawn.

#### Rejection III:

Claims 54-56, 59, and 61 have been rejected as unpatentable over Fukino et al. in view of US 2001/0019760 (Kawamura) and US 6,444,750 (Touhsaent). This rejection is moot since these claims have been cancelled.

Rejection IV:

Claims 57 and 58 have been rejected as unpatentable over the combination of Fukino et al., Kawamura, Touhsaent, US 2002/0054981 (Deutsch et al.), and US 5,556,583 (Tashiro et al.). This rejection is also moot since the noted claims have been cancelled.

Rejection V:

Claim 69 has been rejected as being unpatentable over Fukino et al. taken with Kawamura and Touhsaent. This rejection is moot since Claim 69 has been cancelled.

Rejection VI:

Lastly, Claim 70 has been rejected as unpatentable over Fukino et al. in view of Kawamura, Touhsaent and Applicant's "admitted prior art" on page 10 (lines 6-11) of the present application. This rejection is also moot since Claim 70 has been cancelled.

Response to Examiner's Comments (pp.10-11):

In paragraph 7, the Office Action points out that the rejection over Fukino et al. includes citation to both [0165] and [0246] and admits that those paragraphs teach "either" PVA or polyacrylic acid. It then concludes that both compounds could be used in combination, but no reasoning is presented for this conclusion. As pointed out above, there is no explicit teaching of a combination of PVA and polyacrylic acid. Only Applicant's disclosure makes that connection. It is more likely that only one or neither of the compounds would be used by a skilled artisan since they are used only singly in some of the Examples of Fukino et al., and they are not even described as the preferred compounds. Merely pointing out where each component is mentioned is insufficient for support of either a Section 102(b) or Section 103(a) rejection.

The arguments in paragraph 8 are rebutted in Applicant's arguments presented on pages 4-11 of this paper.

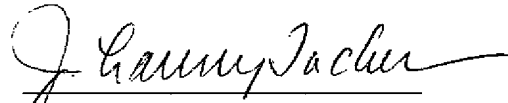
Applicant's response to the use of Hallman et al. in the rejection of Claim 42 is provided on page 10 of this paper.

In paragraph 10, the Office Action refers to Touhsaent and the arguments made earlier in the Office Action. It also alludes to Applicant's prior statement about this reference (last sentence in last full paragraph on page 10 of previous response). Applicant retracts the statement that "[i]t merely suggests that a hydrophilic coating can be made resistant to attack by fountain solution". This statement was erroneously made and is not representative of the current understanding by Applicant or the undersigned representative about the teaching in Touhsaent. As pointed out above, Touhsaent has nothing to do with lithography. It is directed to crosslinking PVA films that can be used as packaging, especially food packaging. Such packaging can be imprinted with images, but it is not used for printing as a lithographic printing plate would be used for the printing. As such, no one skilled in the lithographic art would bother to consult Touhsaent. Thus, it is not "prior art" for the purposes of a Section 103(a) rejection as required by the criteria established in *Graham vs. John Deere* 383 U.S. 1, 17-18, 148 U.S.P.Q. 459, 467 (1966).

The background in Touhsaent alludes to the sensitivity of PVA to moisture—that is well known outside of Touhsaent—so PVA is crosslinked to provide the desired barrier properties for packaging purposes. PVA is the predominant component of the packaging film. This is not the case for the imaging layer or coating used in the presently claimed invention where PVA is a relatively small component of the imaging layer (1-15 wt % only). Thus, the use of Touhsaent for any of the rejections is improper.

In view of the foregoing amendments and remarks, reconsideration of this patent application is respectfully requested. A prompt and favorable action by the examiner is earnestly solicited.

Respectfully submitted,

A handwritten signature in cursive script, reading "J. Lanny Tucker". The signature is written in dark ink and is positioned above a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,489	06/09/2005	Murray Figov	91255MGB JLT	7114

1333 7590 07/10/2007  
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JUL 13 2007

PATENT LEGAL STAFF

*advisory action*

EXAMINER

ZIMMERMAN, JOSHUA D

ART UNIT PAPER NUMBER

2854

MAIL DATE DELIVERY MODE

07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.





**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/538,489

Applicant(s)

FIGOV, MURRAY

Examiner

Joshua D. Zimmerman

Art Unit

2854

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

1. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
2. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
3. ☐ Other: \_\_\_\_\_.

  
JUDY NGUYEN  
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments have been fully considered, but are not found persuasive.

Further, the amendment to claim 40 now specifies that the polyvinyl alcohol (PVA) and polyacrylic acid (PAA) both be present at a certain percentage. This is a new issue since, previously, the specified percentages were not interdependent, and were claimed in such a way as to be interpretable in the alternative; for example, if PVA were required to be present between 1% and 15% (previously presented in claim 47), PAA could still be present in any amount. Newly presented claim 40 now requires a combination between the percentages of both PAA and PVA that was not previously claimed and as such constitutes new issues which require further search and/or consideration.

61-157-1

<p><b>Response under 37 C.F.R. 1.116</b> <b>- Expedited Examining Procedure -</b> <b>Examining Group 2854</b></p>
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**MAIL STOP AF**  
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**Customer No. 01333**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Murray Figov

OFFSET PRINTING BLANK AND  
METHOD OF IMAGING BY INK JET

Serial No. 10/538,489

Filed 08 December 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Group Art Unit: 2854

Examiner: Zimmerman, Joshua D.

*submitted 11/10/2007*

Sir:

**PETITION UNDER 37 C.F.R. 1.181**

**Applicant respectfully petitions the Commissioner to reverse Examiner Zimmerman's refusal to enter Applicant's second Rule 116 amendment that was submitted to the USPTO on June 12, 2007, and to direct entry of that amendment.**

A copy of the noted second Rule 116 amendment is attached for the Commissioner's convenience.

**FACTS:**

1. Examiner Zimmerman stated in his first Office Action mailed September 20, 2006 that he searched and considered the subject matter of each of newly presented Claims 40-53 and thus, the subject matter of dependent Claims 46-48, 51, and 52 as they relate to the "article" of Claim 40 that was also searched and considered. He applied the cited art, EP 1,057,622 (Fukino et al.), against each "article" claim either as being anticipatory or as rendering the claimed subject matter unpatentable.

2. The present application, with Claims 40-59 and 61-71, were finally rejected in an Office Action mailed March 22, 2007.

3. Applicant submitted a timely first amendment under Rule 116 on May 15, 2007 (within two months of "final" rejection) in which the independent article and method Claims 40, 54, and 69 were amended by incorporating the subject matter of cancelled dependent article Claims 46-48, 51, and 52.

4. Applicant received an Advisory Action mailed May 25, 2007, signed by Examiner Judy Nguyen, in which entry of the noted first Rule 116 amendment was refused because the "added limitations in the independent claims requiring a range of concentrations of the components raise a new issue".

5. Sometime between June 4 and 6, 2007 (not sure of exact day), the undersigned attorney called Examiner Zimmerman to seek a more complete explanation of the refusal to enter the first Rule 116 amendment.

6. While there is no written record of this interview, the undersigned attorney was led to believe from the conversation that Examiner Zimmerman and apparently Examiner Nguyen believed that the proposed amendments to add ranges of components to the various independent claims raised a new issue because the cancelled dependent claims had been directed to the claimed "article" (Claim 40) and not the claimed "methods" (Claims 54 and 69). Thus, from that conversation, the undersigned attorney believed that a Rule 116 amendment would more likely be entered with the amended "article" claims if the proposed "method" claims were cancelled. The undersigned attorney communicated the substance of this interview to the Applicant in Israel via e-mail on June 6, 2007 with a proposal to Applicant that the "method" claims be cancelled in a second Rule 116 amendment.

7. Applicant agreed and a second Rule 116 amendment was submitted to the USPTO in a timely manner on June 12, 2007 (before the 3-month

deadline after the “final” rejection) in which the same amendments were made to article Claim 40, but method Claims 54-70 were cancelled without prejudice. Arguments for patentability over the prior art were also submitted, now directed to novelty and patentability of the amended “article” claims only.

8. Applicant received a second Advisory Action mailed July 10, 2007 (almost a month after Applicant’s last submission) in which the second Rule 116 amended was refused entry because: (1) the arguments did not place the application in condition for allowance as they had been previously considered, and (2) the amendment to article Claim 40 raised a new issue since the incorporated features from the dependent claims were not previously specified as interdependent and were previously claimed to be interpretable in the alternative. Thus, the Advisory Action argued that the “combination of percentages present of both PAA and PVA that was not previously claimed and as such constitutes new issues which require further search and/or consideration.”

9. Applicant has until September 22, 2007 to file a Notice of Appeal or to refile the present application, with appropriate fees for extensions of time.

10. Proposed amended Claim 40 can be seen in the attached second Rule 116 amendment.

11. A copy of unamended Claims 40-53 is also attached to show the features of dependent Claims 46-48, 51, and 52.

**REASONS WHY THIS PETITION SHOULD BE GRANTED:**

Applicant respectfully submits that his second Rule 116 amendment should be entered as it will further prosecution and simplify issues for any appeal. Applicant’s arguments as to the novelty and patentability of amended Claim 40 (and remaining dependent claims) have not yet been fully considered. Moreover, Applicant believes that the Examiner has sufficiently considered the subject matter added to amended Claim 40 from the dependent claims so that no new issue is raised for requiring a new search or consideration.

With respect to the first reason for non-entry of Applicant's second Rule 116 amendment, Applicant would submit that Applicant's arguments relating to amended Claim 40 have not been considered during prosecution. The Advisory Action argues otherwise, but if amended Claim 40 has not yet been entered into the application, Applicant's arguments specific to that amended Claim 40 could not have been considered. Thus, the first reason for non-entry is incorrect.

Applicant also believes that the second reason for non-entry is incorrect.

The undersigned attorney regrets that he did not insist on a written summary of the substance of the interview with Examiner Zimmerman in early June, but relied instead upon about 30 years of experience and practice before the USPTO in which such an interview record would be automatically provided with the next action by the Office. Thus, the undersigned attorney is now relying primarily upon recollection and an e-mail communication with Applicant as to the substance of that discussion. Upon reliance on that conversation, the second Rule 116 amendment was submitted in a good faith attempt to meet the expectations of both Examiner Zimmerman and presumably his supervisor, Examiner Nguyen, i.e. that cancellation of the method claims having the same new subject matter would expedite matters and at least provide amended "article" Claim 40 for an appeal.

Therefore, it seems to be an overly rigid approach to examination practice now to refuse entry of the second Rule 116 amendment containing subject matter that was previously searched and considered.

The Examiner is basically saying that he did not previously search or consider the combinations of features (components and range of amounts) that are now incorporated into amended Claim 40 even though those features were presumably searched and considered individually. Applicant believes that this is contrary to standard USPTO examination practice. Moreover, in an era when application filings are increasing beyond the Office's ability to handle them without a significant increase in the backlog, it seems contrary to the interests of Applicant, the public, and the Office, to refuse entry of an amendment that reduces the scope of the claimed invention and cancels other subject matter (i.e.

methods), and thereby renders the present application either allowable or more ready for an appeal.

Several provisions in the MPEP provide guidance for this situation as it gives direction to examiners in the searching and consideration of claimed subject matter.

MPEP 904.01: “During patent examination, the claims are given the *broadest reasonable interpretation* consistent with the specification.” (emphasis added)

Applicant’s specification properly provides support for all of the features of amended Claim 40, including the features newly incorporated from dependent claims. Such features are described in the usual drafting fashion as individual features with accompanying details. There is no explicit mention that such features are to be used alone. The understanding from the context of the specification is just the opposite. In particular, the Examples describe certain embodiments of the claimed components and amounts in combinations. Thus, Applicant’s specification is to be interpreted to have the broadest reasonable interpretation in which the various components may be used in the described amounts individually, or in combination. The preferred embodiments (both components and amounts), as demonstrated in the Examples, would be as combinations. Thus, the Office examination process must consider both possibilities in its searching and consideration.

MPEP 904.02 (second paragraph): “The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed.”

MPEP 904.02(a) (second paragraph): “The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.”

Applicant would reiterate that the disclosed features of Claim 40 would reasonably be expected to include individual use of the ranges of amounts of components as well as their combinations. It is clearly reasonable to expect combinations of the ranges of components to be claimed, as in amended Claim 40, particularly in view of the teaching in Applicant’s Examples as well as the

text of the general disclosure. To assume otherwise is to ignore the suggested approach to searching described in the MPEP and to be overly rigid in searching only the explicit subject matter of each claim. Applicant believes that it is reasonable to search the combinations of dependent claims. Fewer applicants now use multiple dependent claims because of the exorbitant costs associated with them. Moreover, the Office is in the process of promulgating new rules in which the number of claims likely will be limited in order to reduce the growing backlog of the Office. The various approaches by the Office to reduce the backlog are reasonable only if MPEP 904.02 is consistently followed so that “reasonable” combinations of claimed subject matter are searched and considered at the same time, not in successive continuing applications.

MPEP 904.03 (first paragraph): “It is a prerequisite to a speedy and *just* determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, *especially if only broad claims are presented*; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant’s amendment.” (emphasis added)

MPEP 904.03 (last paragraph): “[T]he Examiner should study the specification or description sufficiently to determine the full value of the reference disclosure relative to the *claimed or claimable subject matter*.” (emphasis added)

Examiners may have various ideas as to what subject matter may be incorporated into a claim or be claimable subject matter, and it is not expected that every insignificant feature of the disclosure will be searched and considered in view of the limit of time and space allotted by the Office for each pending application. However, the features that Applicant considers important enough to present in claims, albeit dependent claims, should be the primary focus of the searching and consideration and it is not unreasonable for such features to be searched and considered in combinations when the Applicant’s disclosure



describes embodiments containing such combinations (e.g. the Examples). Such combinations (using specific components in specific amounts) are certainly “claimable subject matter”. To ignore such combinations in looking for pertinent prior art, reviewing such art, and presenting the examination results in one or more non-final office actions, is not a “speedy and just determination” of the issues. Moreover, it is not a speedy and just determination that when such claimable combinations are presented under standard practice after a “final” rejection (i.e. from already searched dependent claims), entry of such claimable combinations is refused.

Presumably, the Examiner followed the instructions in the MPEP in his examination of Claims 40-53 early in the prosecution. Thus, presumably, he searched for and considered the subject matter of Claims 46-48, 51, and 52, and their combinations with Claim 40 and each other. He has cited Fukino et al. as allegedly describing or teaching individual components of Applicant’s claimed lithographic printing blank. Presumably, he would have considered whether that same reference taught the individual or combined amounts of such components. The mere fact that the combination of amounts was not in the originally searched independent claim is irrelevant. Those combinations are “reasonable” and “claimable” subject matter especially in view of Applicant’s Examples and other explicit disclosure. It is obvious that the claimed amounts of components can be used with each other and with the claimed article of Claim 40 from a reasonable reading and interpretation of Applicant’s disclosure. Thus, it matters not that the component amounts were not claimed in various combinations in claims dependent upon original Claim 40.


Admittedly, in order to avoid duplicity of claims and significant costs, Applicant did not provide multiple dependent claims, or additional dependent claims with various combinations of components and amounts. To expect this type of claiming practice where applicants are trying to reduce intellectual property costs and the USPTO is complaining about its workload, is unreasonable and an overly rigid approach to examination.

Applicant believes that he has, in good faith, followed standard and good practice in prosecution of this application, and has done so without trying to delay prosecution unnecessarily in any fashion. It is to Applicant’s benefit that a speedy and just determination be made in this case so the application can be

quickly passed to allowance or to consideration by the Board of Patent Appeals and Interferences. Applicant has simplified the issues by canceling the "method" claims that they presumed from the noted conversation with Examiner Zimmerman were the main concern, and they have reduced the number of claims by adding previously searched and considered claimed and claimable subject matter to the single independent Claim 40.

For all of these reasons, Applicant requests that this Petition be granted and that their second Rule 116 amendment be entered. Expedited consideration of this Petition is requested so there is sufficient time for action before the last opportunity for appeal.

Respectfully submitted,

  
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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Attachment A

Claims 1-39 (canceled)

40. (new) A lithographic printing blank comprising a coating deposited from aqueous fluid onto a substrate, the coating comprising:
- polyvinyl alcohol;
  - polyacrylic acid;
  - hydrophobic water-based emulsion with pH of 7 or below;
  - aminoplast; and
  - at least one wetting agent.
41. (new) The lithographic printing blank of claim 40, wherein the coating is hydrophilic.
42. (new) The lithographic printing blank of claim 40, wherein the coating is oleophilic.
43. (new) The lithographic printing blank of claim 40, wherein the aminoplast is a urea-formaldehyde resin.
44. (new) The lithographic printing blank of claim 40, wherein the hydrophobic water-based emulsion has one of a phenol formaldehyde and an acrylic polymer or copolymer as its internal phase.
45. (new) The lithographic printing blank of claim 40, wherein the coating has a dry coating weight between 1 gram per square meter and 4 grams per square meter.
46. (new) The lithographic printing blank of claim 40, wherein the polyacrylic acid is present at between 20% and 60% of the dry coating weight.

- 47.(new) The lithographic printing blank of claim 40, wherein the polyvinyl alcohol is present at between 1% and 15% of the dry coating weight.
- 48.(new) The lithographic printing blank of claim 40, wherein the hydrophobic water-based emulsion is present at between 25% and 55% of the dry coating weight.
- 49.(new) The lithographic printing blank of claim 40, wherein the wetting agent comprises silicone surfactant.
- 50.(new) The lithographic printing blank of claim 40, wherein the at least one wetting agent is present at between 0.5% and 7% of the dry coating weight.
- 51.(new) The lithographic printing blank of claim 41, wherein the aminoplast is present at not more than 10% of the dry coating weight.
- 52.(new) The lithographic printing blank of claim 42, wherein the aminoplast is present at between 10% and 20% of the dry coating weight.
- 53.(new) The lithographic printing blank of claim 40, wherein the substrate comprises one of untreated aluminum, aluminum treated with phosphoric acid and anodized aluminum.